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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,391	06/10/1999	GERRIT H. SOEPENBERG	PHN-16.974	8047

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EXAMINER

LEVITAN, DMITRY

ART UNIT	PAPER NUMBER
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2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	09/329,391	SOEPENBERG ET AL.	
	Examiner	Art Unit	
	Dmitry Levitan	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/04/2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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Amendment, filed 12/19/06, has been entered. Claims 1-8 and 10-14 remain pending.

Specification

1. In the light of Applicant's amendment, the objection to the title of the invention has been withdrawn.
2. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

The attempt to incorporate subject matter into this application by reference to ISO/IEC International Standard 13818-6, MPEG-2 Digital Storage Media Command and Control" July 12, 1996 is ineffective because the document is not publicly available.

Drawings

3. The drawings were received on 09/04/02. These drawings are not approved, because they appear to be informal. If this is the case, when application is allowed, applicant will be required to submit new formal drawings.

Claim Rejections - 35 USC § 112

4. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not provide sufficient details to enable a skilled in the art to make and use the invention because it does not adequately describe the following:

Regarding claim 12, how to insert/extract information into/from userInfo field of a DSM-CC DownloadInfoIndication message, as the message structure, generation and destination are not properly disclosed;

The specification does not provide enough details about the structure and operation of the elements associated with the above identified claimed features to enable one skilled in the art to make and use the invention without undue experimentation.

5. In light of Applicant's amendment, the rejection of claim 14 under 35 U.S.C. 112, second paragraph, has been withdrawn.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Claims 7 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claimed signal is not directed to one of the four types of statutory subject matter: a process, a machine, manufacture or composition of matter.

See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, page 57. OG notice, 22 Nov. 2005.

Claim Rejections - 35 USC § 103

7. Claims 1-8, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski (US 5,420,866) in view of Kostreski (US 5,734,589).

8. Regarding claims 1, 3, 5 and 7 Wasilewski substantially teaches the limitations of the claims:

a transmission system (see Fig. 2) for transmitting a multiplex signal 68 (see Fig. 4) from a transmitter 8 (satellite uplink) to a receiver 201(subscriber location, see col. 8 lines 1-30).

Multiplex signal 68 carries Program Map Table (PMT) to each decoder (see col. 10 lines 8-30).

Signal 68 has at least a module 72 (Program Definition 2 on Fig. 4) comprising at least one object 80 (Elementary Stream Definition 2 on Fig. 4).

Receiver 201 (see Fig. 6 and col. 13 lines 35-68) has extracting means (decoder 110) for extracting objects 80 from the multiplex signal 68. Decoder 110 is adapted to extract objects 80 (Elementary Stream Definition 2, Fig. 4) based on the module 72 (Program Definition 2, Fig. 4) related information 74 (Program Number, Fig. 4). Module related information 74 is included in the multiplex signal 68 (see Fig. 4).

Wasilewski does not teach using a carousel having a plurality of modules and the objects including executable code.

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Kostreski teaches using a data carousel to create a customized program guide for users col. 5, line 55 through col. 6 line 6 and downloading to the customer terminal an executable software to provide the customer with new services, col. 4 lines 39-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add using a data carousel and the objects including executable code of Kostreski to the system of Wasilewski to improve the system operation for the users by creating customized program guides and add new services to produce video/audio information outputs to the customer actions.

9. Regarding claims 2, 4, 6 and 8 Wasilewski discloses a transmission system (see rejection of claim 1 above) where module related information (Program Definition 2 on Fig. 4) is contained in a single information section (Program Number 74 on Fig. 4) of the transport stream 68.

10. Regarding claims 10, 11 and 13, Wasilewski in view of Kostreski substantially teaches the limitations of the claim (see claim 1 rejection above).

Wasilewski does not teach modules to include a pre-fetch tag for information extraction and extraction means.

Kostreski teaches tags to identify user selected broadcast channels and download/pre-fetch the available channels col. 5 line 32-54, extracting them from the broadcast stream and inherently using extraction means to extract the pre-fetch tags, because the extraction means are essential for the system operation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add pre-fetch tag for information extraction, including the extraction means, of

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Kostreski to the system of Wasilewski to improve the system operation by making all selected channel information available for the user.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski in view of Kostreski in further view of Cobbley (US 5,614,940).

Wasilewski in view of Kostreski substantially teaches the limitations of the claim (see claims 1 and 13 rejection above).

Wasilewski in view of Kostreski does not teach modules to include versions and the receive does not pre-fetch modules when the modules with the same versions are already stored in the receiver.

Cobbley teaches the modules comprise versions to identify old and new versions of the broadcasted programs and terminating the delivery of the old version when the new is available, col. 9, lines 20-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add modules to include versions and the receive does not pre-fetch modules when the modules with the same versions are already stored in the receiver of Cobbley to the system of Wasilewski in view of Kostreski to improve the system operation by delivering the latest version of the broadcast program to the user.

Response to Arguments

12. Applicant's arguments filed 12/19/06 have been fully considered but they are not persuasive.

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On page 6 of the Response, Applicant argues that Applicant had no intentions to incorporate ISO/IEC standard.

Examiner respectfully disagrees.

The specification describes the transmission system as a system “known from the International Organization for Standardization/International Electrotechnical Commission (ISO/IEC) Standard 13818-6” on page 9 of the disclosure, clearly using the ISO/IEC standard as a reference.

In addition, Claim 12 is directed to a DSM-CC DownloadInfoIndication message, which is again using the ISO/IEC standard as a reference 6:30-7:2.

Therefore, there is an attempt to incorporate the standard into the disclosure without using “incorporated by reference statement” and other appropriate procedures. See 37 CFR 1.57(f).

On page 6 of the Response, Applicant argues that claim 12 cannot be rejected under 35 U.S.C. 112, first paragraph because it is supported by the specification.

Examiner respectfully disagrees.

Examiner clearly identified the pertinent portions of the claimed material which are not supported by the disclosure.

A DSM-CC DownloadInfoIndication message, as disclosed in the Applicant cited portion of the disclosure (6:29-7:2) does not describe the message structure, generation and destination and does not teach how to insert/extract information into/from userInfo field of a DSM-CC DownloadInfoIndication message, as the message structure, generation and destination are not properly disclosed

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Therefore, the specification does not provide enough details about the structure and operation of the elements associated with the above identified claimed features to enable one skilled in the art to make and use the invention without undue experimentation

The previous and current Office actions are provided to Applicant for a review and a rebuttal.

On page 7 of the Response, Applicant argues that amended claims 7 and 8 limitations are statutory.

Examiner respectfully disagrees.

Claim 7 limitations are directed to a signal, as computer readable medium is a portion of the claim preamble, because the computer readable media is not referred in the body of the claim.

Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, clearly identify signal as nonstatutory subject, see pages 55-57.

On pages 7-9 of the Response, Applicant argues that there is no motivation to combine Wasilewski and Kostreski references.

Examiner respectfully disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, both teaching are clearly belong to analogous art, as they are directed to a digital multimedia broadcast system, distributing video and audio programs to the customers.

In addition to the program delivery teaching of Wasilewski, Kostreski teaches using a carousel 5:60-6:6 and downloading executable code to control the customer interaction with the service provider to provide different services 4:39-67.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add using a data carousel and the objects including executable code of Kostreski to the system of Wasilewski to improve the system operation for the users by creating customized program guides and add new services to produce video/audio information outputs to the customer actions.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding Applicants arguments directed to the limitations of claim 1, Wasilewski teaches a plurality of modules, each comprising at least one object, and Kostreski teaches a data carousel to create a customized program guide for users and downloading to the customer terminal an executable software to provide the customer with new services. See claim 1 rejection above for details.

It was clearly stated in the previous Office action, that claim 12 has been rejected under 35 U.S.C. 112, first paragraph, but has not been rejected under 35 U.S.C. 103(a).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Levitan whose telephone number is (571) 272-3093. The examiner can normally be reached on 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on (571) 272-7529. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Handwritten signature of Dmitry Levitan, consisting of stylized initials 'DL' followed by a cursive signature.

Dmitry Levitan
Primary Examiner
Art Unit 2616

**DMITRY LEVITAN
PRIMARY EXAMINER**